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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,627

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Junichi Nio

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/521,627

Applicant(s)

NIO ET AL.

Examiner

Jordan M. Schwartz

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. PCT/JP03/09016.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>foreign reference</u> .                |

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/JP03/09016, filed on July 16, 2003.

### ***Information Disclosure Statement***

The information disclosure statement filed January 13, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Specifically, copies were not provided for any of the cited foreign references and therefore these references have been crossed out and have not been considered.

### ***Specification***

The specification is objected for the following reason: in the preliminary amendment to the specification filed on January 13, 2005, in the first paragraph of the specification, applicant sets forth the date of application of PCT/JP/09016 as July 7, 2003. However, the application date for this PCT document is apparently July 16, 2003. Correction to the first paragraph of the specification is required.

### ***Claim Rejections - 35 USC § 112***

Claim 1 (and dependent claims 2-4) is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, applicant uses the terms “first lens”, “second lens” etc and it is not clear if applicant is using this terminology to imply an order of these lenses from the object side (the assumed meaning for purposes of examination) or if applicant is using this terminology merely to label the lenses. The lack of clarity renders the claims vague and indefinite. Specifically, by the claim language, while the second lens has to be on the image side of the first lens, and the third lens has to be on the image side of the second lens, no such restriction has been claimed with reference to the fourth lens. Therefore, it is not clear if the term “fourth lens” is implying that it must be on the image side of the third lens or if it can be anywhere within the lens system. As a suggestion, applicant may want to claim “A lens apparatus comprising, in order from an object side to an image side: a first lens... (which is the assumed meaning for purposes of examination). Furthermore, the claimed “that faces a concave surface of the first lens” creates a lack of clarity since, presumably, if an intended order of the lenses is intended, as set forth above, then the second lens will inherently face a concave surface of the first lens. Therefore, if the language “in order from an object side to an image side” is added to the claim, then the language “that faces a concave surface of the first lens” is not adding any additional limitation to the claim and should be deleted from the claim for additional clarity.

With further reference to claim 1, that part of the claim stating “any one surface of the first lens and the fourth lens having a non-spherical surface” renders the claim vague and indefinite. Specifically, it is not clear if applicant is claiming that either the first or fourth lens comprises at least an aspherical surface i.e. “any one surface of the first

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lens or the fourth lens having a non-spherical surface” (the assumed meaning for purposes of examination), or if applicant is claiming that both the first and fourth lenses comprise at least one aspherical surface i.e. “any one surface of the first lens and any one surface of the fourth lens each having an aspherical surface” and further clarity is required.

### ***Claim Objections***

Claim 1 (and dependent claims 2-4) is objected to for the following reason. Since the intended meaning could be determined from what is set forth in the specification and figures a 112 rejection was not made but instead this lack of clarity issue is being set forth in the claim objection below.

In claim 1, lines 6-7, “convex back surface” creates a lack of clarity by the use of the term “back”. Apparently, from what is set forth in the specification and figures, applicant means the image side surface and it is suggested that “convex back surface” be changed to “convex image side surface” to provide additional clarity.

Claim 1 is further objected to because of the following informality: “wherein following conditions” should be corrected to “wherein the following conditions” to provide grammatical correctness. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Sato et al publication number 2003/0161050.

Sato et al reads on these claims by disclosing the limitations therein including the following: a lens apparatus (abstract, Figure 3, embodiment 3) comprising in order from the object side to the image side (the assumed meaning); a meniscus lens having a convex surface facing the object side (Figure 3, embodiment 3, "G1"); a second lens that faces a concave surface of the first lens (Figure 3, embodiment 3, "G2"); a third lens having a concave surface that faces the second lens (Figure 3, embodiment 3, "G3"); a fourth lens having positive power and having a convex back surface (Figure 3, embodiment 3, "G4"); satisfaction of the first condition of claim 1 (embodiment 3,  $v_3 = 23.8$ ,  $v_4 = 53$ ); satisfaction of the second condition of claim 1 ( $Y_{\max}/f = 0.53$ ); satisfaction of the third condition of claim 1 (embodiment 3 re  $\Sigma d = 6.99$  and  $f = 6.26$ ); any one surface of the first lens or the fourth lens having a non-spherical surface (the assumed meaning, embodiment 3); the second lens having a convex back surface facing the image side (Figure 3, embodiment 3, "G2"); and a light control unit between the first and second lens (Figure 3, embodiment 3, re the stop between the first and second lenses).

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese document number 11-30745 (Jp'745).

Jp'745 reads on these claims by disclosing the limitations therein including the following: a lens apparatus (English abstract) comprising in order from the object side to the image side (the assumed meaning); a meniscus lens having a convex surface facing the object side (see figures and corresponding examples such as figure 1, example 1, r1-r2); a second lens that faces a concave surface of the first lens (see figures and corresponding examples such as figure 1, example 1, r3-r4); a third lens having a concave surface that faces the second lens (see figures and corresponding examples such as figure 1, example 1, r5-r6); a fourth lens having positive power and having a convex back surface (see figures and corresponding examples such as figure 1, example 1, r7-r8); satisfaction of the first condition of claim 1 (see figures and corresponding examples such as figure 1, example 1); satisfaction of the third condition of claim 1 (see figures and corresponding examples such as figure 1, example 1); any one surface of the first lens or the fourth lens having a non-spherical surface (the assumed meaning, see figures and corresponding examples such as example 1); the second lens having a convex back surface facing the image side (see figures and corresponding examples such as example 1, r3-r4). It is believed that Jp'745 would inherently satisfy the second condition of claim 1, this being reasonably based upon the similarity in structure between Jp'745 and that of the claimed invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al publication number 2003/0161050 or Jp'745 in view of Nanba patent number 6,236,521.

Sato et al and Jp'745 disclose as is set forth above including disclosing the lens apparatus comprising in order a first negative lens, a second positive lens, a third negative lens and a fourth positive lens (Sato et al, figure 3, embodiment 3, Jp-745, English abstract) but neither specifically discloses a filter between the fourth lens and the imaging plane. Nanba teaches that in a lens apparatus comprising in order a first negative lens unit, a second positive lens unit, a third negative lens unit and a fourth positive lens unit (abstract) that it is desirable to further include a filter between the image side positive lens and the image plane for the purpose of filtering out undesirable light (Figure 1, "107", column 7, lines 21-38). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lens apparatus of either Sato et al or Jp'745 as further comprising a filter between the image side positive lens and the image plane since Nanba teaches that in a lens apparatus of similar structure that it is desirable to further include a filter between the image side positive lens and the image plane for the purpose of filtering out undesirable light.

### ***Double Patenting***

Claims 1-4 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4 of copending Application No. 11/347,629. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
October 23, 2006